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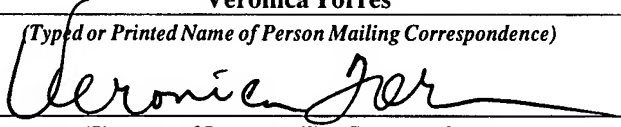
CERTIFICATE OF MAILING BY FIRST CLASS MAIL (37 CFR 1.8) Applicant(s): Miller, et al.	Docket No. Miller-001:CIP
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Application No. 10/730,431	Filing Date December 8, 2003	Examiner Rowan, Kurt C.	Customer No. 021897	Group Art Unit 3643
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Invention:
Improved Automatic Fish Hook and Method of Use

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**TRANSMITTAL LETTER
(General - Patent Pending)**

Docket No.
Miller-001:CIP

In Re Application Of:

Miller, et al.

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
10/730,431	December 8, 2003	Rowan, Kurt C.	021897	3643	2329

Title:

Improved Automatic Fish Hook and Method of Use

COMMISSIONER FOR PATENTS:

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Response to Notice of Non-Compliant Appeal Brief.**

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Signature

Dated: **October 11, 2007**

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cc:



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Miller, et al.

Serial No.: 10 / 730,431

Filed: 8 December 2003

For: *Improved Automatic Fish Hook and
Method of Use*

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Attorney Docket: **Miller-001:CIP**

Examiner: Rowan, Kurt C.

Art Unit: 3643

RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Notice of Non-Compliant Appeal Brief mailed 21 September 2006,
please find the following:

- A Supplemental Appeal Brief which lists the claims filed on
November 29, 2004 in the claims appendix as opposed to the
claims filed June 24, 2005.

Although no additional fee is required with this Response, the Commissioner is hereby
authorized to charge any deficiencies or credit any overpayment to USPTO Deposit Account No.
13-2166.

Respectfully submitted,

10-11-07
Date

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	§	
	§	
JIM J. MILLER ET AL.	§	Attorney Docket: Miller-001:CIP
	§	
Serial No.: 10/730,431	§	Examiner: Kurt C. Rowan
	§	
Filed: December 8, 2003	§	Art Unit: 3643
	§	
For: IMPROVED AUTOMATIC FISH	§	
HOOK AND METHOD OF USE	§	

SUPPLEMENTAL APPEAL BRIEF UNDER 37 C.F.R. 41.37

COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellants hereby submit this Amended Appeal Brief under 37 C.F.R. 41.37. In furtherance of the Notice of Appeal under 37 C.F.R. 1.191, filed June 24, 2005, to the Board of Patent Appeals and Interferences, to appeal the decision of the Examiner of the Final Rejection of Claims 1-15 and 17-20, for the above designated application, Appellants hereby submit the information and arguments as required and in the order as specified under 37 C.F.R. 41.37(c), including the amendment of the Status of Claims (paragraph #3), and the amendment to the Argument (paragraph #7) relating to the rejected claims.

1. Real Party in Interest

The real parties in interest are James J. Miller and Francis E Charleville, the applicants in the above designated case.

2. Related Appeals and Interferences

None.

3. Status of Claims

Appellants respectively submit the following set of claims, which Appellants believe are the claims under appeal. Each claim listed hereunder, which is designated as rejected, is being

appealed in the instant appeal.

1. (Rejected) An improved automatic fish hook apparatus formed from a single wire comprising:

a first shank having a distal end;

a second shank having a distal end;

a tensioner disposed intermediate said first shank and said second shank at about the middle of said single piece of wire; and

a catch, integral to said first shank, comprising an offset disposed about said first shank, and releasably in communication with said second shank,

wherein

said first shank and said second shank having a first state and a second state, said first state disposing said first shank and said second shank in substantially parallel planes and said second state disposing said first shank and said second shank crossed once, whereby in said first state, said first shank and said second shank depend down from said tensioner,

and whereby

said catch maintains said first shank and said second shank in said second state wherein said distal end of said first shank being at least partially obscured by said second shank and said distal end of said second shank being at least partially obscured by said first shank by crossing said distal ends of the respective shanks, and further whereby upon the application of two generally opposing forces applied about said first shank and said second shank, said first shank and said second shank are released into said first state, wherein the two generally opposing forces are independent of any pulling force exerted upon said fish hook apparatus.

2. (Rejected) The improved fish hook of Claim 1, whereby in said first state, said respective distal ends, of said first shank and said second shank, being positioned in opposing directions.

3. (Rejected) The improved fish hook of Claim 1, wherein said first shank comprises a first hook having a distal end.

4. (Rejected) The improved fish hook of Claim 3, wherein said first hook further comprises a barb disposed about said distal end of said first hook.
5. (Rejected) The improved fish hook of Claim 1, wherein said second shank comprises a second hook having a distal end.
6. (Rejected) The improved fish hook of Claim 5, wherein said second hook further comprises a barb disposed about said distal end of said second hook.
7. (Rejected) The improved fish hook of Claim 1, wherein said tensioner comprises a spring.
8. (Rejected) The improved fish hook of Claim 1, wherein said tensioner comprises a coil.
9. (Rejected) The improved fish hook of claim 1, wherein said tensioner comprises one or more coils of said single wire.
10. (Rejected) The improved fish hook of Claim 1, further comprising a prong along each of said first shank and said second shank.
11. (Rejected) The improved fish hook of Claim 1, further comprising an eyelet disposed about and intermediate said first shank and said second shank.
12. (Rejected) The improved fish hook of Claim 1, wherein said single wire comprises a metal.
13. (Rejected) The improved fish hook of Claim 12, wherein said metal is selected from the group consisting of steel, iron, aluminum, copper, an alloy of steel, an alloy of iron, an alloy of aluminum, an alloy of copper and combinations thereof.

14. (Rejected) The improved fish hook of Claim 1, wherein said single wire comprises a composite material.

15. (Rejected) An improved releasably biasable apparatus formed from a single piece of wire comprising:

a first shank having a distal end;

a second shank having a distal;

a tensioner disposed intermediate said first shank and said second shank at about the middle of said single piece of wire; and

a catch, integral to said first shank, comprising an offset disposed about said first shank, and releasably in communication with said second shank,

wherein

said first shank and said second shank having a first state, a second state, and a third state, said first state disposing said first shank and said second shank in substantially parallel planes, said second state disposing said first shank and said second shank crossed, and said third state disposing said first shank and said second shank crossed twice,

whereby

in said first state, said first shank and said second shank depend down from said tensioner,

and whereby

said catch maintains said first shank and said second shank in said second state wherein said distal end of said first shank is at least partially obscured by said second shank and said distal end of said second shank is at least partially obscured by said first shank by crossing said distal ends of the respective shanks, and further whereby

upon the application of two generally opposing forces, applied about said first shank and said second shank, said first shank and said second shank are released into said third state wherein the two generally opposing forces are independent of any pulling force exerted upon said fish hook apparatus.

16. Cancelled

17. (Rejected) An improved automatic fish hook apparatus formed from a single wire comprising:

a first shank and a second shank, each having a distal end, and together having a first state and a second state, said first state disposes said first shank and said second shank in substantially parallel planes and depending down from a tensioner and said second state disposes said first shank and said second shank crossed once;

said tensioner being disposed intermediate said first shank and said second shank at about the middle of said single piece of wire; and

a catch, integral to said first shank, comprising an offset disposed about said first shank, and releasably in communication with said second shank,

wherein

said catch maintains said first shank and said second shank in said second state whereby said distal end of said first shank is at least partially obscured by said second shank and said distal end of said second shank is at least partially obscured by said first shank by crossing said distal ends of the respective shanks,

and further wherein upon the application of two generally opposing forces applied about said first shank and said second shank, said first shank and said second shank are released into said first state, whereby in said first state, said first shank and said second shank depend down from said tensioner and are in substantially parallel planes and with said respective distal ends being positioned in opposing directions wherein the two generally opposing forces are independent of any pulling force exerted upon said fish hook apparatus.

18. (Rejected) The improved fish hook of Claim 17, wherein said first shank comprises a first hook having a distal end and wherein said second shank comprises a second hook having a distal end.

19. (Rejected) The improved fish hook of Claim 18, wherein said first shank comprises a first hook having a distal end and wherein said second shank comprises a second hook having a distal end and further wherein said respective distal ends, of said first hook and said second hook, each having a barb disposed about said distal ends.

20. (Rejected) An improved automatic setting fish hook made from a single wire comprising: a coiled spring having first and second members extending outwardly from the coiled spring, the first member having a curved end such that the end of the wire curves back toward the coiled spring, the second member extending outwardly in a substantially, similar direction to said first member,

said second member having an offset in the wire adjacent to its end such that to cock the automatic hook, the end of the first member is bent inwardly towards the second member, the second member is bent inwardly toward the first member, wherein the second member longitudinally is positioned on one side of the coil and the first member longitudinally is positioned on the other side of the coil, and wherein the offset of the second member, when it is bent inwardly, fits on the other side of the curved end of the first member so that the offset catches the end of the first member so that the first and second members are locked in position relative to each other, whereby when a fish grabs the ends of the members in their mouth, it overcomes the offset catch, and whereby the ends of the first and second members spring back outwardly away from each other to set the hook; and

said first and second members further comprise hooks adjacent to said ends.

4. Status of the Amendments

The Appellants submit that two (2) amendments have been filed subsequent to the Final Office Action mailed February 24, 2005. Appellants filed an Amendment in response to the Final Office action (mailed February 24, 2005) on April 25, 2005. This Amendment was not entered in an Advisory Action mailed May 20, 2005.

The second Amendment was filed in conjunction with the Notice of Appeal on June 24, 2005. This Amendment was marked as being not entered in an Advisory Action mailed July 11, 2005.

5. Summary of Claimed Subject Matter

As claimed, this invention is an improved automatic fish hook formed from a single wire (page 11 commencing at line 1 and Figures 5-10). The improvement, over prior art fish hooks, is that the subject fish hook is formed from a single wire, is designed to store energy in a cocked coil, and is automatically set by the action of a fish's mouth. There is no intervention required

from the fisherperson to set the hook (page 13 commencing at line 1, page 13 commencing at line 14, page 14 commencing at line 13, page 16 commencing at line 21 through page 17 commencing at line 1, page 18 commencing at line 16, and page 19 commencing at line 3).

The improved automatic fish hook comprises a spring loaded integrally formed coil (17, Figs. 5-10) or a coil spring of a certain width having a first shank (18a, Figs. 5-10) and a second shank (18b, Figs. 5-10) with the two shanks being offset by the width (page 11 commencing at line 8, page 11 commencing at line 14, and Figures 5-10).

Further the coil (17, Figs. 5-10) has a first end and a second end so that the first shank (18a, Figs. 5-10) extends outwardly from the first end of the coil and the second shank (18b, Figs. 5-10) extends outwardly from the second end of the coil (17, Figs. 5-10) and each shank has a first portion, a curved portion (14, Figs. 5-10), and a distal portion (19a, 19b, Figs. 5-10) (page 11 commencing at line 14 and Figures 5-10).

Further the first shank (18a, Figs. 5-10) has an offset (13, Figs. 5-10) that is bent or curved the width of the coil (17, Figs. 5-10) (page 11 commencing at line 17, page 11 commencing at line 19, page 14 commencing at line 10, page 16 commencing at line 1, and Figures 5-10). Therefore, the distal end of the first shank is in substantially the same plane as the second shank (i.e. the distal end of the first shank is in a plane that is substantially parallel to the plane in which the portion of the first shank between the curved portion (14, Figs. 5-10) and the coil (17, Figs. 5-10) lies.

The offset (13, Figs. 5-10) is a curved or bent part of the shank (18a, Figs. 5-10) and is therefore integral to the shank (18a, Figs. 5-10) and is not a piece or part that is attached to the shank such as by welding etc. (page 14 commencing at line 10 and Figures 5-10). The offset is used as a catch so as to keep the two shanks together when the fish hook is in the cocked position (page 12 commencing at line 10 through page 13 commencing at line 1 and Figures 5-10). The shanks of the fish hook have two (2) states. In the first state, the first shank (18a, Figs. 5-10) and the second shank (18b, Figs. 5-10) are in substantially parallel planes (page 11 commencing at line 13 and Figures 5-10). In the second state, the shanks are positioned such that the first shank and the second shank are crossed once (page 12 commencing at line 10 and Figures 5-10). Thus, in the first state, the first shank and the second shank extend from the coil (page 11 commencing at line 13 and Figures 5-10). In the second stage, the catch maintains the first shank and the second shank so that the distal portion the first shank is at least partially

obscured by the second shank and the distal end of the second shank is at least partially obscured by the first shank ((page 11 commencing at line 13 and Figures 5-10). When the fish hook is cocked (in the second stage) and there is an application of two generally opposing forces applied about the first shank and the second shank, such as when the hook is in a fish's mouth, the shanks are moved so as to release the catch and move from the second state back to the first state (page 13 commencing at line 1 and Figures 5-10). The two generally opposing forces are independent of any pulling force exerted upon the fish hook by the fish, the fisherperson, or any combination of the two.

The automatic fish hook will also function if the application of two generally opposing forces applied about the first shank (18a, Figs. 5-10) and the second shank (18b, Figs. 5-10) cause the fish hook to mis-set (page 13 commencing at line 12 and Figures 6C). In such a case, the shanks will actually have three (3) states. The first and second state are as described above and the third state (the "mis-set") will position the first shank and the second shank so that they are crossed twice (page 13 commencing at line 12 and Figures 6C). Thus, when there is an application of two generally opposing forces applied about the first shank and the second shank, such as when the hook is in a fish's mouth, and the hook mis-sets, the shanks are moved so as to release the catch and move from the second state to a third state (page 13 commencing at line 12 and Figures 6C). In this case, the two generally opposing forces are still independent of any pulling force exerted upon the fish hook by the fish, the fisherperson, or any combination of the two.

When improved fish hook is in the first state, the respective distal ends of the shanks are positioned in opposing directions (page 11 commencing at line 1 and Figures 5-10) The fish hooks can be used for a variety of fishing including catch and release, hunting, or other sport fishing activities. Therefore, either or both of the shanks can further comprise hooks or hooks with barbs (19a, 19b, 23, Figs. 5-10) at the respective ends of the shanks or can have other prongs along the shanks depending on the specific use and purpose of the fish hook (page 11 commencing at line 17 and Figures 5-10). The coil (17, Figs. 5-10) of the present fish hook can comprise one or more coils of the single wire. (page 11 commencing at line 8 and Figures 5-10). The number of coils of the single wire can vary depending on the material used for the wire, the fish being targeted, the desired tension of the hooks in the cocked position, and various other factors relating to the fishing experience (page 11 commencing at line 10 and Figures 5-10).

When using the fish hook, the fishing line can be connected through at least a part of an eyelet (Figs. 5-10) typically formed by the coil (page 17 commencing at line 18 and Figures 5-10). The single wire hook can be made from various materials such as metal selected from the group consisting of steel, iron, aluminum, copper, an alloy of steel, an alloy of iron, an alloy of aluminum, an alloy of copper, it can be of a composite material, or any combinations thereof (page 8 commencing at line 20 through page 9 commencing at line 1).

6. Grounds of Rejection to be Reviewed on Appeal

Whether Claims 1-6, 9-15, and 18-20 are unpatentable under 35 U.S.C. 103 over U.S. Patent No. 1,638,923 to Danielson in view of U.S. Patent No. 2,748,521 to Schaefer?

Whether Claim 20 is in definite under the second paragraph of 35 U.S.C. 112?

7. Argument

Claims 1-6, 9-15, and 18-20 are patentable over Danielson (U.S. Patent No. 1,638,923 in view of Schaefer(U.S. Patent No. 2,748,521)).

Appellants believe and respectfully submit that the single ground of rejection (i.e. rejection under 35 U.S.C. 103 over U.S. Patent No. 1,638,923 to Danielson in view of U.S. Patent No. 2,748,521 to Schaefer) applies separately to three (3) groups of Claims as follows:

- | | |
|---------|--------------|
| Group 1 | Claims 1-14 |
| Group 2 | Claims 15-19 |
| Group 3 | Claim 20 |

Claim groups 1 (Claims 1-14), 2 (Claims 15-19), and 3 (Claim 20) do not stand or fall together as they are separately patentable and therefore must be separately reviewed in light of the appealed rejection under 35 U.S.C. 103. Claim 1 is directed to an automatic fish hook that inter alia comprises two states - relaxed or set and cocked. Claim 15 is directed to an automatic fish hook that inter alia comprises three states - relaxed, cocked, and set wherein the relaxed state and the set state are totally separate states that find the fish hook in different configurations. Claim 20 does not claim a catch, as limited in Claims 1 or 15, it does claim a coiled spring which is not claimed in Claims 1 nor 15, and it does claim shanks with hooks, which are not found in Claims 1 nor 15. Thus each of the independent Claims 1, 15, and 20, are separately patentable

and cannot stand or fall together.

Based on the Examiner's Office Actions, the Examiner now only maintains one art rejection regarding the patentability of Appellants' invention. The Examiner is using the same rejection (that the claims are unpatentable under 35 U.S.C. 103 over Danielson in view of Schaefer) against each separate group of claims (Claims 1-14, Claims 15-19, and Claim 20).

Rejection under 35 U.S.C. 103 over U.S. Patent No. 1,638,923 to Danielson in view of U.S. Patent No. 2,748,521 to Schaefer

Appellants respectfully submit that although, as discussed above, the grouped claims do not stand or fall together, at least a portion of the argument, in support of each claim grouping, is similar. Therefore, to avoid redundancy of arguments, under each subheading of grouped claims, Appellants will incorporate, as necessary, by reference from a previous subheading arguments which apply to each subheading instead of separately and redundantly repeating such argument. By this approach, Appellants are in no way waiving that the Board must consider the patentability of the grouped claims separately but are only arranging the arguments, as such, due to the Office Action comments of the Examiner and as a way to maintain clarity and ease of understanding of the arguments.

Claims 1-14

1. Appellants' device, the automatic fish hook is clearly patentable over all the prior art that the Examiner has cited in the prosecution of this application including Danielson and Schaefer.
2. The Examiner stated that Danielson teaches an integral catch 6 on both shanks and further requires a post or pin 7 which is **not** a part of the hook but is a part of a **separate** "inanimate life-like fish bait 1". The post or pin 7 is required to hold both hooks (and both integral catches 6) in the crossed position. Thus, a pull or setting action, by the fish swimming away or the fisherman setting the hook is required. There is **no automatic set** with Danielson.
3. In sharp contrast, the Appellants' "**catch, integral to said first shank**" (i.e. only one catch integral to only one shank), keeps the shanks crossed. Danielson teaches to rely on **three** catches - one on each shank and the third being pin 7. Further, the Appellants' device is formed from a single wire. Danielson teaches a multi-part device wherein pin 7 is **not** a part of the hook

but must be employed to keep the shanks crossed. Still further, it is clear that the Appellants' shanks are crossed one time in the second state (cocked position) wherein Danielson teaches that the shanks are crossed twice in the cocked position (Danielson Fig.1).

4. In response to this argument, by the Appellants, the Examiner, in the Final Office Action dated February 24, 2005, stated "As to the shanks of Danielson being crossed twice in the cocked position as shown in Fig. 1, it should be pointed out that the shanks 2,2 are crossed once and the curved part of the hook 10, 10 are also crossed once." Thus, the Examiner acquiesces to the differences pointed out by Appellants regarding the difference in the operation of the Danielson hook but ignores these differences in the continued rejections.

5. Further in reply to the Appellants' Response/Amendment, filed November 29, 2004, wherein the Appellants pointed out the differences in the catches, the Examiner stated that because Appellants employ the open-ended term "comprising" there is no preclusion of having another catch 7. Appellants have amended the claims to show that the Appellants' catch is the offset in the shank and as such does not include another catch separate from the single wire. However, the Examiner has refused twice to enter or consider such amendment.

6. The Examiner alleges that "Danielson shows upon the application of two generally opposing forces such as a fish biting the lure from the top and the bottom and consequently the hook, that the hook will be pulled forward by the force on the line as a fisherperson feels the bite which will release the hooks from the lure as shown in Fig. 2." Thus, the Examiner is alleging that the Appellants' claim of the "application of two generally opposing forces" means that the first force is the fish's bite and the second opposing force is the pull of the line by the fisherman. Appellants amended the claims to clarify that the two generally opposing forces are independent of any pulling force exerted upon said fish hook apparatus. Thus, Appellants pointed out to the Examiner that the present device does not require any cooperation between the fisherperson and the fish. The Appellants' device requires no pulling of the fishing line by either the fish or the fisherperson. Appellants further respectively submit that if a fish bites the Danielson hook and swims toward the fishing pole (i.e. wherein slack remains in the fishing line) the Danielson hook will not be set. In sharp contrast, the Appellants' hook will set (i.e. be released from the second position) upon the application of two generally opposing forces by the interior of the fish's mouth, applied about said first shank and said second shank without any pulling motion on the line by the fish or the fisherperson.

7. Further, Danielson must be crossed two times, in the cocked position, because Danielson relies on a separate post or pin 7 in order for the hooks to remain cocked. Danielson cannot be cocked without this pin 7 and thus the Danielson catches are not analogous to the Appellants integral catch. In sharp contrast, the Appellants' catch is an offset in the shank which not only holds the shanks in the cocked position but actually switches the planes in which the end of the shanks lie when in the cocked position. The Appellants claims are clear that the Appellants catch is wholly part of the single wire fish hook and does not rely on any other pin or post to function.

8. The Examiner also alleged that "Danielson employs what has been referred to as an automatic set since any set can be automatic in that it is done by a user without thinking." Appellants respectfully disagree with the Examiner's simplification of the fishing process. Quite to the contrary, if a user does not think about setting a hook when using a conventional fishing hook, the user will seldom catch any fish. The setting of the hook is very critical during fishing. If a hook sets too soon or too late, it will not properly pierce the fish's mouth resulting in a missed catch and possible needless injury to the fish. The Appellants' hook distinguishes itself from the prior art hooks in at least one manner with its automatic set. There is no pulling on the fishing line, by the fish or the fisherperson, required to set the Appellants' hook. The setting is done by the forces exerted by the fish's mouth.

9. The Examiner further alleged that it would be obvious to provide Danielson with a release as shown by Schaefer since one merely mechanical equivalent release is being substituted for another and the function is the same. Appellants respectfully disagree and point out that there is absolutely no motivation provided in either Schaefer or Danielson to combine their teachings. Danielson teaches a single wire hook that relies on an outside catch (7) to maintain the device cocked and thus preventing the device from being automatically set. Schaefer teaches a multi-part hook assembly that cannot possibly be made from a single wire. The release mechanism of Schaefer cannot be physically incorporated into the Danielson device. The leaf spring (7) of Schaefer must be separate from the shanks (1). To set and/or release the Schaefer device requires that the shanks (1) move within the leaf spring (7) or more likely that the leaf spring (7) must move into or out of the notched areas (10). Thus in order for Danielson to employ the release of Schaefer, the Danielson coil spring (9) would have to be replaced by a separate leaf spring or at least be separated from the shanks (2). Therefore, the combination of Danielson and Schaefer cannot be a single wire fish hook. As such, no one skilled in the art would be motivated to

combine Schaefer and Danielson to create a single wire fish hook because the Schaefer device is multi-piece and cannot be made from the same single wire that forms the fish hook. Further, there can be no reasonable expectation of success because Schaefer must be multi-part to work as taught and thus Schaefer would be destroyed and could not work if it were made from a single wire. Similarly, the Danielson hook would be destroyed if it required the addition of a separate coil/spring assembly.

10. Appellants, during the prosecution of the application under appeal, attempted to further amended the claims to clearly distinguish the Appellants' unique offset/catch from the prior art hooks (i.e. the Appellants' offset catch is bent or curved substantially the width of the coil thus allowing the shanks to be held in the cocked position). Further, as seen in Appellants' Figs. 5 & 6, of the application, the distal end 19a of the shank 18a lies clearly in substantially the same plane as the second shank 18b and its distal end 19b. With the boards approval, Appellants stand ready to amend the current claims to include these limitations to further distinguish over the prior art.

11. The Appellants filed, on June 24, 2005, an Amendment under 37 C.F.R. 1.116 in conjunction with the Notice of Appeal under 37 C.F.R 1.191. In this amendment, Appellants tried to further narrow the issues for appeal or to place the application in a condition for allowance by cancelling Claims 7 and 8 (these claims were dependent on Claim 1 and were redundant after the amendment of Claim 1) and cancelling independent Claim 17.

Claims 15-19

Appellants respectfully incorporate paragraphs 1-6 and 8-10 of the argument for Claims 1-14 presented hereinabove.

Regarding Claim 15, the Examiner alleges that Danielson teaches three states with the third state having the shanks crossed twice (i.e. the cocked position). Per Claim 15, the Appellants' third state (when the shanks are crossed twice) occurs when the hook is set. When the Appellants' hook is in the cocked position (second state) the shanks are only crossed one time. Appellants respectfully point out that when the Danielson hook is set, the shanks are not crossed and when the Danielson hook is cocked, the shanks are crossed twice. Thus, Danielson does not teach nor disclose that the shanks are crossed once in the cocked position and then are crossed twice in the set position. In response to this argument, by the Appellants, the Examiner,

in the Final Office Action dated February 24, 2005, stated “Regarding claim 15 and the number of times the shanks are crossed, Applicant shows several embodiments such as Figs. 6-7C where the hook shanks are crossed between zero and two times depending on the configuration and the status of the apparatus such as a cocked state of (sic) released state. Hence the number of times the shanks are crossed is deemed a matter of design choice since the function is the same and no showing of criticality has been made (no unexpected results).”

This is simply incorrect. Danielson must be crossed two times, in the cocked position, because Danielson relies on a separate post or pin 7 in order for the hooks to remain cocked. Danielson cannot be cocked without this pin 7 and thus the Danielson catches are not analogous to the Appellants integral catch. In sharp contrast, the Appellants’ catch is an offset in the shank which not only holds the shanks in the cocked position but actually switches the planes in which the end of the shanks lie when in the cocked position. The Appellants claims are clear that the Appellants catch is wholly part of the single wire fish hook and does not rely on any other pin or post to function.

Claim 20

Appellants respectfully incorporate paragraphs 1-6 and 7-10 of the argument for Claims 1-14 presented hereinabove.

Appellants respectfully submit that the Examiner has never specifically addressed Claim 20 in a separate rejection. Claim 20 was added in an Office Action Response filed November 29, 2004. Claim 20 was first rejected in the Final Office Action dated February 24, 2005. Claim 20 was rejected along with Claims 1-15 and 17-19 as being unpatentable over U.S. Patent No. 1,638,923 to Danielson in view of U.S. Patent No. 2,748,521 to Schaefer. However, no specific comment, by the Examiner, was directed to Claim 20 individually.

Neither Danielson nor Schaefer, alone or in combination, teach, disclose, nor suggest that this offset is used to hold the first member adjacent to the second member when the hook is in its cocked state. Claim 20 further recites that the fishhook is cocked such that when the fish bites or grabs the hook, the force of the fish’s mouth overcomes the offset catch and allows the hooks to spring into their set position. Danielson and Schaefer cannot be combined to teach the disclosure of the instant application for reasons explained hereinabove and because neither reference teaches a single wire fish hook with an integral catch. Further neither reference teaches

that the end of the second member, because of the offset is longitudinally positioned on the opposite side of the coil than is the straight portion of the second member.

35 U.S.C. 112 second paragraph rejection of Claim 20

Claim 20 was added to Appellants' application only before the final rejection. Appellants' subsequent attempts to amend Claim 20 therefore occurred after Appellants' application was finally rejected and have not been entered. As such, with the boards approval, Appellants stand ready to amend Claim 20 as follows. "An improved automatic setting fish hook made from a single wire comprising: a coiled spring, of a certain width, having first and second members offset by said width and extending outwardly from the coiled spring, the first member having a curved end such that the end of the wire curves back toward the coiled spring, the second member having a curved end such that the end of the wire curves back toward the coiled spring, said second member having an offset, such that said offset is bent and/or curved the width of the coil, said offset being in the wire adjacent to its end such that to cock the automatic hook, the end of the first member is bent inwardly towards the second member, the second member is bent inwardly toward the first member, wherein the second member longitudinally is positioned on one side of the coil and the first member longitudinally is positioned on the other side of the coil, and wherein the offset of the second member, when it is bent inwardly, fits on the curved end of the first member so that the offset catches the end of the first member so that the first and second members are locked in position relative to each other, whereby when a fish grabs the ends of the members in their mouth, it overcomes the offset catch, and whereby the ends of the first and second members spring back outwardly away from each other to set the hook; and said first and second members further comprise hooks adjacent to said ends."

While this language was not entered in the Advisory Action dated July 11, 2005, the Advisory Action did indicate this language would overcome the outstanding 112 second paragraph rejection. With the boards approval, Applicant stands ready to take this claim as amended above.

General Arguments and Conclusion

The claims listed in section 3, hereinabove, were originally filed on November 29, 2004

in response to a non-final rejection. Amendments to the claims were attempted after the final rejection on June 24, 2005 under 37 C.F.R. 1.116 along with the Notice of Appeal and were not entered by the Examiner. It is Appellants' belief these amendment put the present application in better form for appeal and should have been entered.

In the Appellants' response, to the Final Office Action dated February 24, 2005 and filed April 25, 2005, Appellants added a new Claim 21. In the first Advisory Action, dated May 20, 2005, the Examiner did not enter the Amendment stating only that " Claim 21 raises new issues which would require further consideration." The Appellants then filed, on June 24, 2005, an Amendment under 37 C.F.R. 1.116 in conjunction with the Notice of Appeal under 37 C.F.R. 1.191. In this amendment, Appellants tried to further narrow the issues for appeal or to place the application in a condition for allowance by cancelling the previously added Claim 21 as well as cancelling Claims 7 and 8 (these claims were dependent on Claim 1 and were redundant after the amendment of Claim 1) and cancelling independent Claim 17.

In the second Advisory Action, the Examiner again refused to enter the Amendment citing only "the limitations of claims 7 and 8 combined with claim 1 raise a new issue since these claims previously depended separately from claim 1." Although Appellants acknowledge that the entry of this amendment is not a matter of right, Appellants contend that this refusal to enter this amendment improper. Since Claims 7 and 8 had always depended from Claim 1 and were never separately rejected under cited art different from that used against Claim 1, there should have been no additional issues raised when the elements of Claims 7 and 8 were included in Claim 1. This amendment cancelled claims, removed issues for appeal, and certainly would not require the Examiner to make more than a cursory review. Specifically, as acknowledged in the Advisory Action dated July 11, 2005 the amendments would have overcome the previous 112 second paragraph rejections. Only claim 20 stood rejected under the second paragraph of section 112.

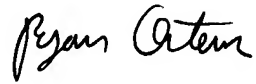
Further, the amendments were made to adopt the Examiner's suggestion that the claims should more closely claim the device as shown in Fig. 6 of the application. Therefore, the Appellants amended the claim language to recite the offset being a bend and/or curve that is the width of the coil. The Appellants' respectfully submit that the recitation that the shank has an offset such that the offset is bent and/or curved the width of the coil means that the offset is a substantially 90 degree offset. This finds support in the original specification at page 11 lines

17-20.

For the Examiner's convenience and as a reminder of the demonstration during the interview of June 15, 2004, Appellants submitted eleven (11) sheets of photographs showing the Appellants' device in interaction with various artificial baits. As can be noted, from the photographs, Appellants' device bears no similarity to the Danielson device. Appellants further submitted that the photographs were not an attempt to introduce any new matter and are only for illustration of matter already described in the specification and claims. These 11 sheets of photographs are attached to the Evidence Appendix herein.

Although Appellants believe that no additional fees are required beyond the fees already submitted for the filing of this Appeal Brief (August 24, 2005), the Commissioner is hereby respectfully authorized to deduct such additional fees or refund any overpayment, as might be required, from or to Deposit Account Number 13-2166.

Respectfully submitted,



Date: 10-11-07

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8. **Claims Appendix**

1. An improved automatic fish hook apparatus formed from a single wire comprising:

a first shank having a distal end;

a second shank having a distal end;

a tensioner disposed intermediate said first shank and said second shank at about the middle of said single piece of wire; and

a catch, integral to said first shank, comprising an offset disposed about said first shank, and releasably in communication with said second shank,

wherein

said first shank and said second shank having a first state and a second state, said first state disposing said first shank and said second shank in substantially parallel planes and said second state disposing said first shank and said second shank crossed once, whereby in said first state, said first shank and said second shank depend down from said tensioner,

and whereby

said catch maintains said first shank and said second shank in said second state wherein said distal end of said first shank being at least partially obscured by said second shank and said distal end of said second shank being at least partially obscured by said first shank by crossing said distal ends of the respective shanks, and further whereby

upon the application of two generally opposing forces applied about said first shank and said second shank, said first shank and said second shank are released into said first state, wherein the two generally opposing forces are independent of any pulling force exerted upon said fish hook apparatus.

2. The improved fish hook of Claim 1, whereby in said first state, said respective distal ends, of said first shank and said second shank, being positioned in opposing directions.
3. The improved fish hook of Claim 1, wherein said first shank comprises a first hook having a distal end.
4. The improved fish hook of Claim 3, wherein said first hook further comprises a barb disposed about said distal end of said first hook.
5. The improved fish hook of Claim 1, wherein said second shank comprises a second hook having a distal end.
6. The improved fish hook of Claim 5, wherein said second hook further comprises a barb disposed about said distal end of said second hook.
7. The improved fish hook of Claim 1, wherein said tensioner comprises a spring.
8. The improved fish hook of Claim 1, wherein said tensioner comprises a coil.
9. The improved fish hook of claim 1, wherein said tensioner comprises one or more coils of said single wire.

10. The improved fish hook of Claim 1, further comprising a prong along each of said first shank and said second shank.

11. The improved fish hook of Claim 1, further comprising an eyelet disposed about and intermediate said first shank and said second shank.

12. The improved fish hook of Claim 1, wherein said single wire comprises a metal.

13. The improved fish hook of Claim 12, wherein said metal is selected from the group consisting of steel, iron, aluminum, copper, an alloy of steel, an alloy of iron, an alloy of aluminum, an alloy of copper and combinations thereof.

14. The improved fish hook of Claim 1, wherein said single wire comprises a composite material.

15. An improved releasably biasable apparatus formed from a single piece of wire comprising:

a first shank having a distal end;

a second shank having a distal;

a tensioner disposed intermediate said first shank and said second shank at about the middle of said single piece of wire; and

a catch, integral to said first shank, comprising an offset disposed about said first shank, and releasably in communication with said second shank,

wherein

said first shank and said second shank having a first state, a second state, and a third state, said first state disposing said first shank and said second shank in substantially parallel planes, said second state disposing said first shank and said second shank crossed, and said third state disposing said first shank and said second shank crossed twice,

whereby

in said first state, said first shank and said second shank depend down from said tensioner,

and whereby

said catch maintains said first shank and said second shank in said second state wherein said distal end of said first shank is at least partially obscured by said second shank and said distal end of said second shank is at least partially obscured by said first shank by crossing said distal ends of the respective shanks, and further whereby

upon the application of two generally opposing forces, applied about said first shank and said second shank, said first shank and said second shank are released into said third state wherein the two generally opposing forces are independent of any pulling force exerted upon said fish hook apparatus.

16. Cancelled

17. An improved automatic fish hook apparatus formed from a single wire comprising:

a first shank and a second shank, each having a distal end, and together having a first state and a second state, said first state disposes said first shank and said second shank in substantially

parallel planes and depending down from a tensioner and said second state disposes said first shank and said second shank crossed once;

said tensioner being disposed intermediate said first shank and said second shank at about the middle of said single piece of wire; and

a catch, integral to said first shank, comprising an offset disposed about said first shank, and releasably in communication with said second shank,

wherein

said catch maintains said first shank and said second shank in said second state whereby said distal end of said first shank is at least partially obscured by said second shank and said distal end of said second shank is at least partially obscured by said first shank by crossing said distal ends of the respective shanks,

and further wherein upon the application of two generally opposing forces applied about said first shank and said second shank, said first shank and said second shank are released into said first state, whereby in said first state, said first shank and said second shank depend down from said tensioner and are in substantially parallel planes and with said respective distal ends being positioned in opposing directions wherein the two generally opposing forces are independent of any pulling force exerted upon said fish hook apparatus.

18. The improved fish hook of Claim 17, wherein said first shank comprises a first hook having a distal end and wherein said second shank comprises a second hook having a distal end.

19. The improved fish hook of Claim 18, wherein said first shank comprises a first hook having a distal end and wherein said second shank comprises a second hook having a distal end

and further wherein said respective distal ends, of said first hook and said second hook, each having a barb disposed about said distal ends.

20. An improved automatic setting fish hook made from a single wire comprising:

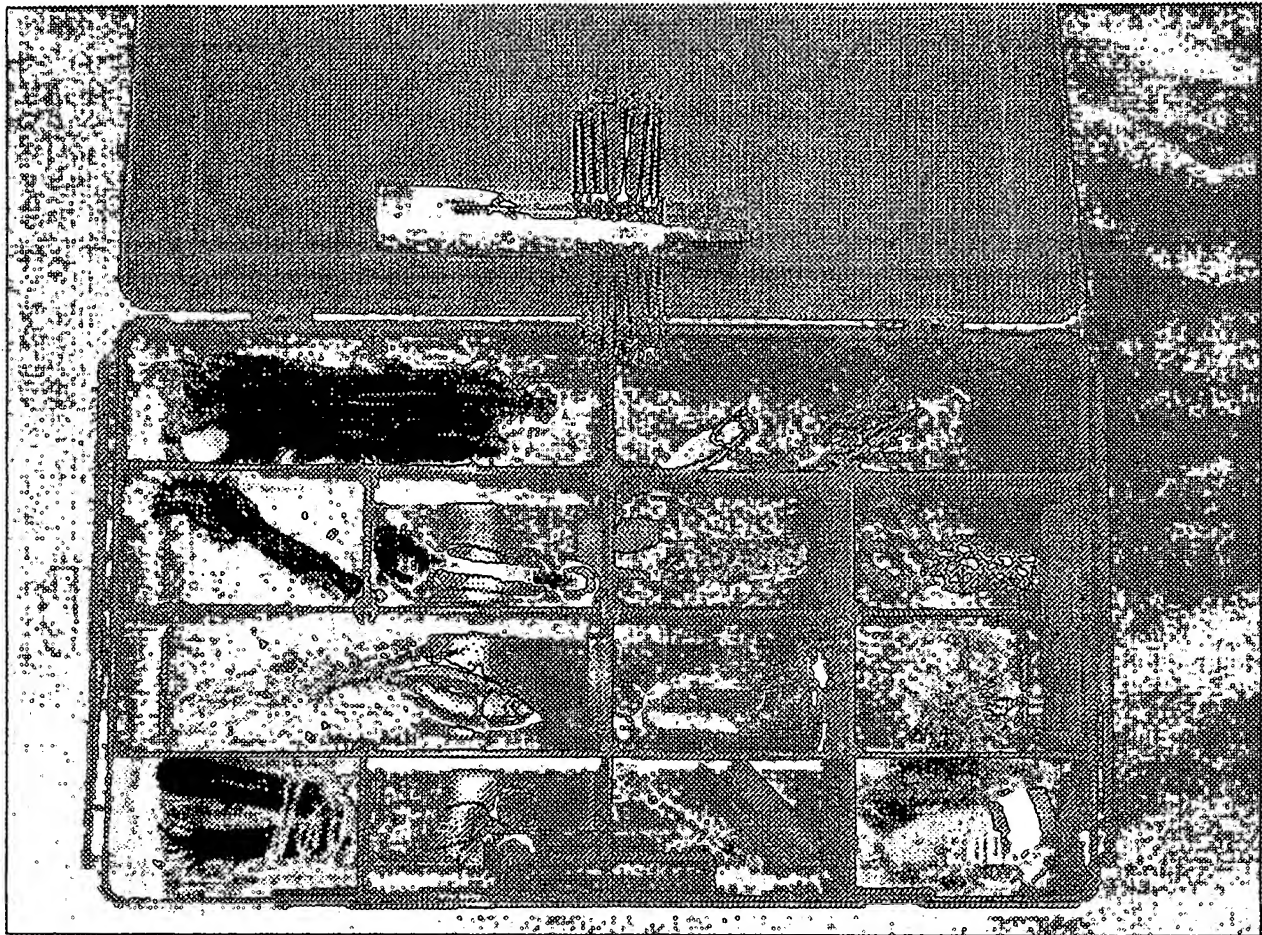
a coiled spring having first and second members extending outwardly from the coiled spring, the first member having a curved end such that the end of the wire curves back toward the coiled spring, the second member extending outwardly in a substantially, similar direction to said first member,

said second member having an offset in the wire adjacent to its end such that to cock the automatic hook, the end of the first member is bent inwardly towards the second member, the second member is bent inwardly toward the first member, wherein the second member longitudinally is positioned on one side of the coil and the first member longitudinally is positioned on the other side of the coil, and wherein the offset of the second member, when it is bent inwardly, fits on the other side of the curved end of the first member so that the offset catches the end of the first member so that the first and second members are locked in position relative to each other, whereby when a fish grabs the ends of the members in their mouth, it overcomes the offset catch, and whereby the ends of the first and second members spring back outwardly away from each other to set the hook; and

said first and second members further comprise hooks adjacent to said ends.

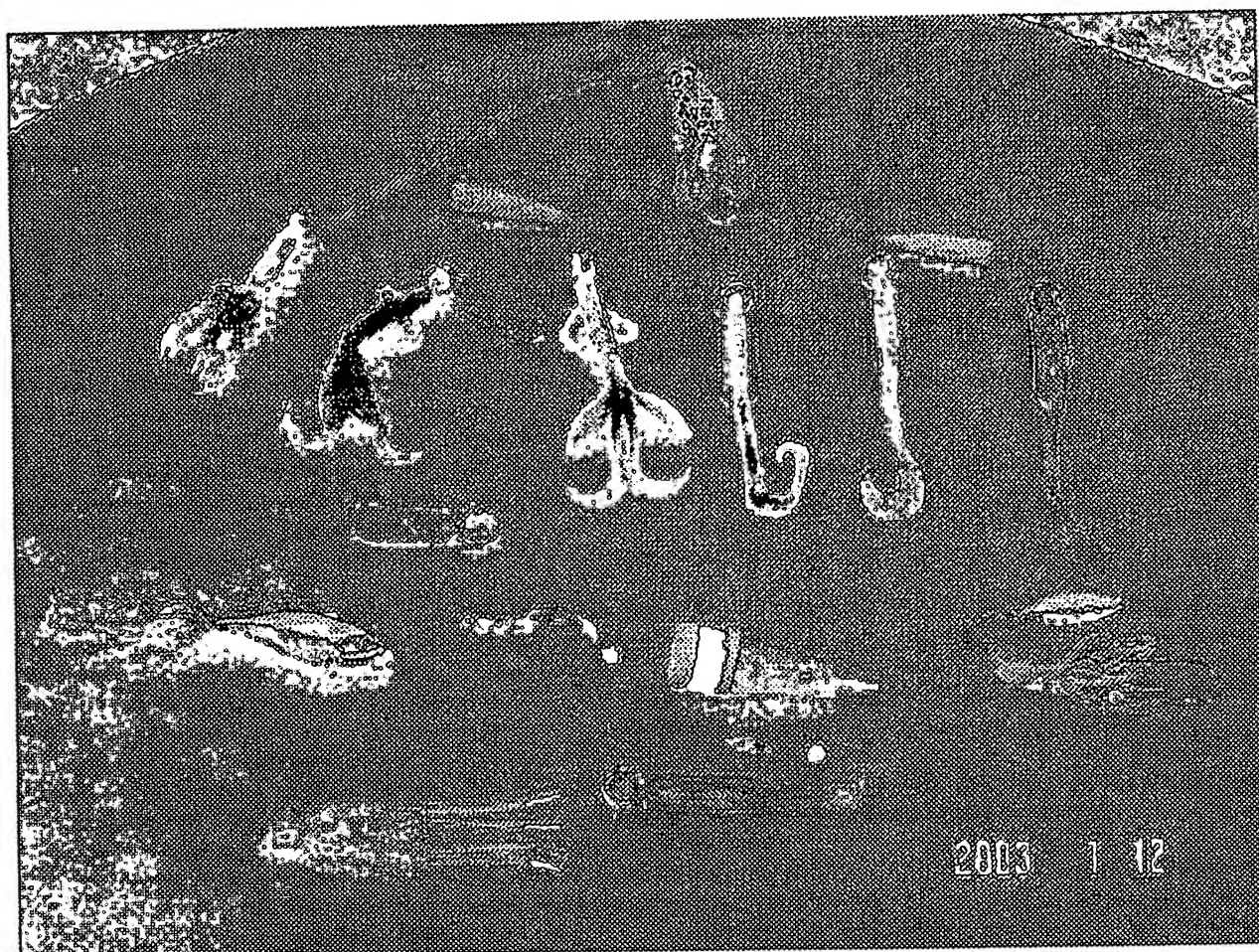
9. Evidence Appendix

For the Examiner's convenience and as a reminder of the demonstration during the personal interview of June 15, 2004, Appellants submitted eleven (11) sheets of photographs showing the Appellants' device in interaction with various artificial baits. As can be noted, from the photographs, Appellants' device bears no similarity to the Danielson device. Appellants further submitted that the photographs were not an attempt to introduce any new matter and are only for illustration of matter already described in the specification and claims. These eleven (11) sheets of photographs provided to the Examiner in the Appellants' response to the USPTO Office Action dated July 28, 2004, which Appellants filed on November 29, 2004.

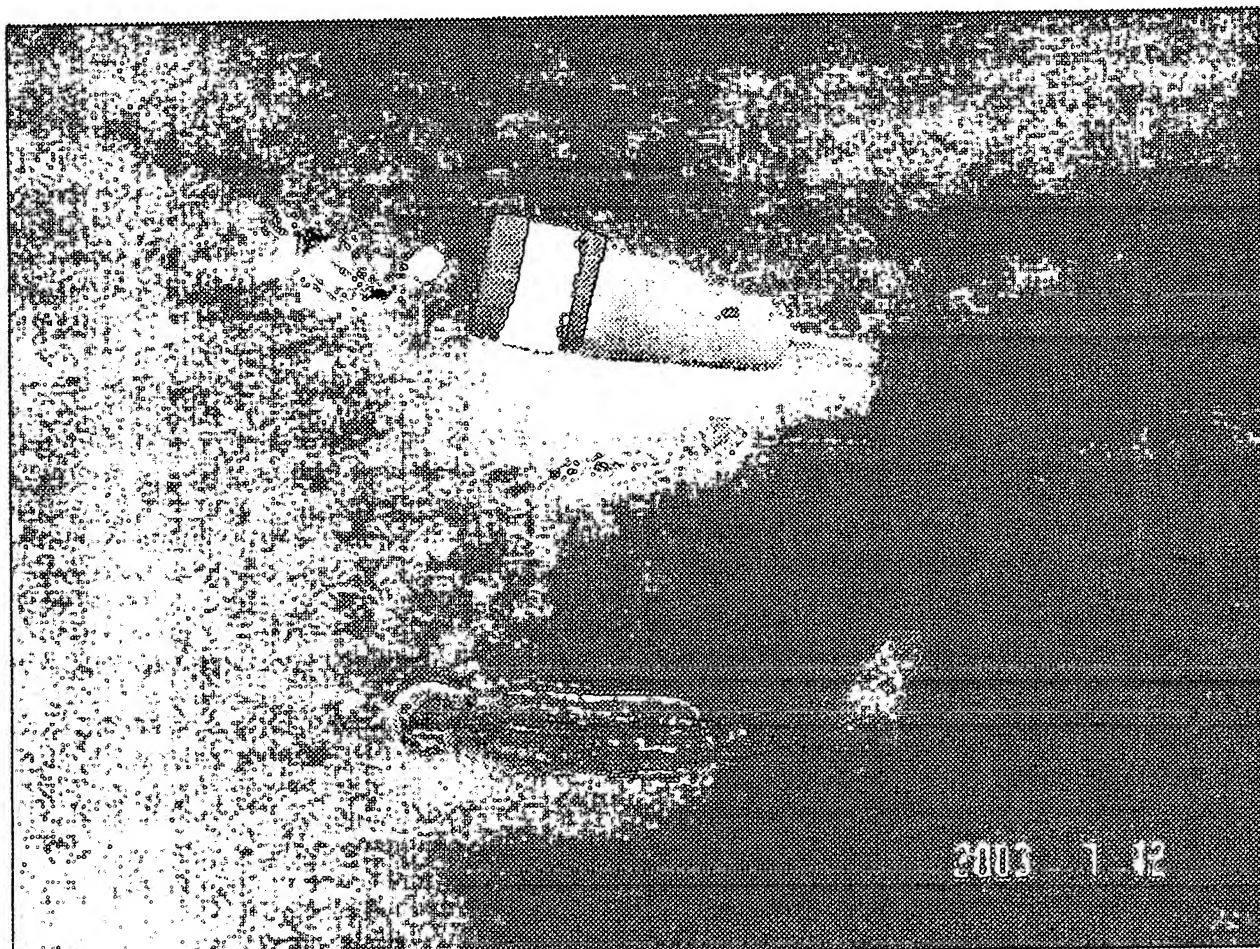


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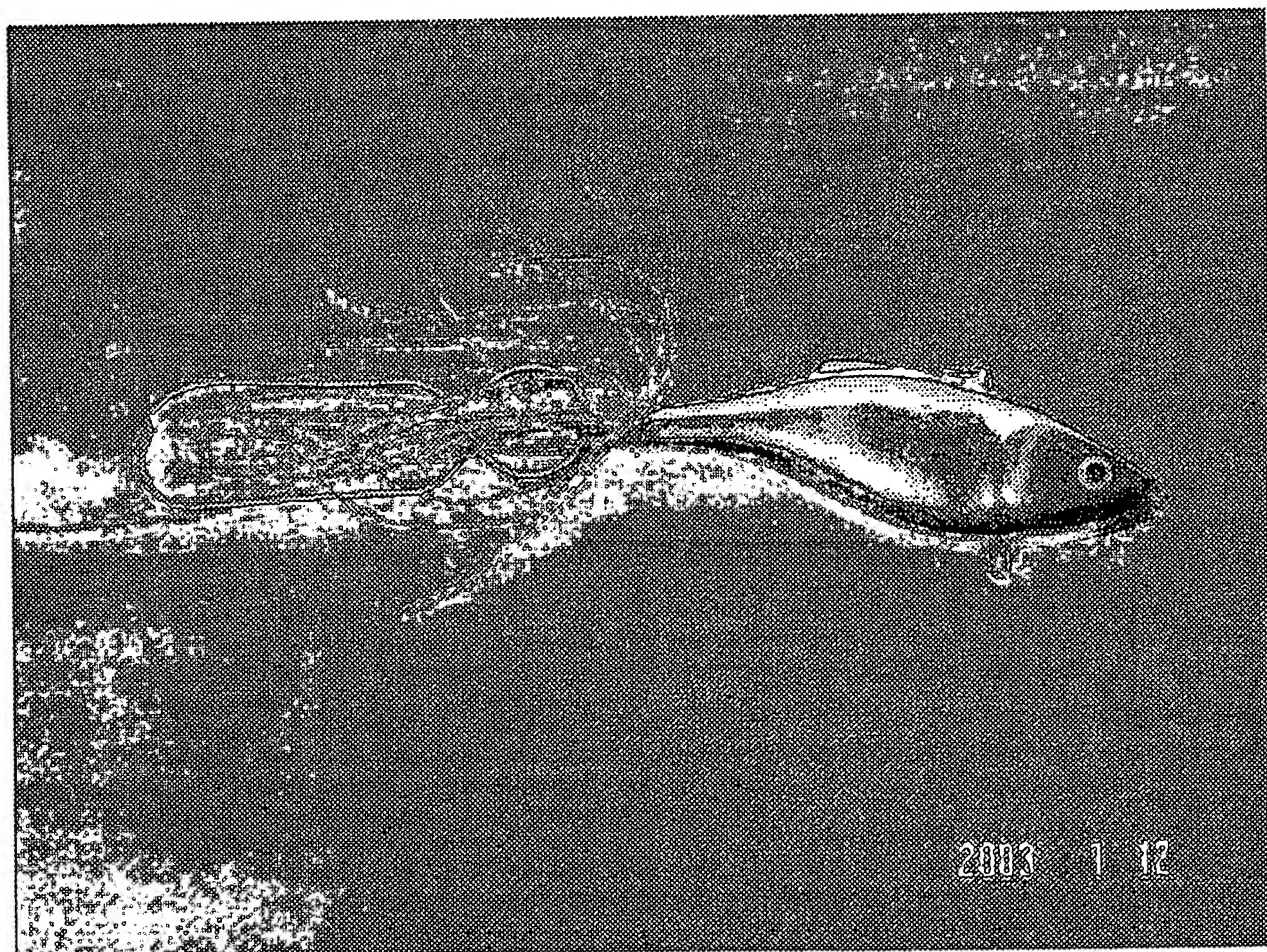




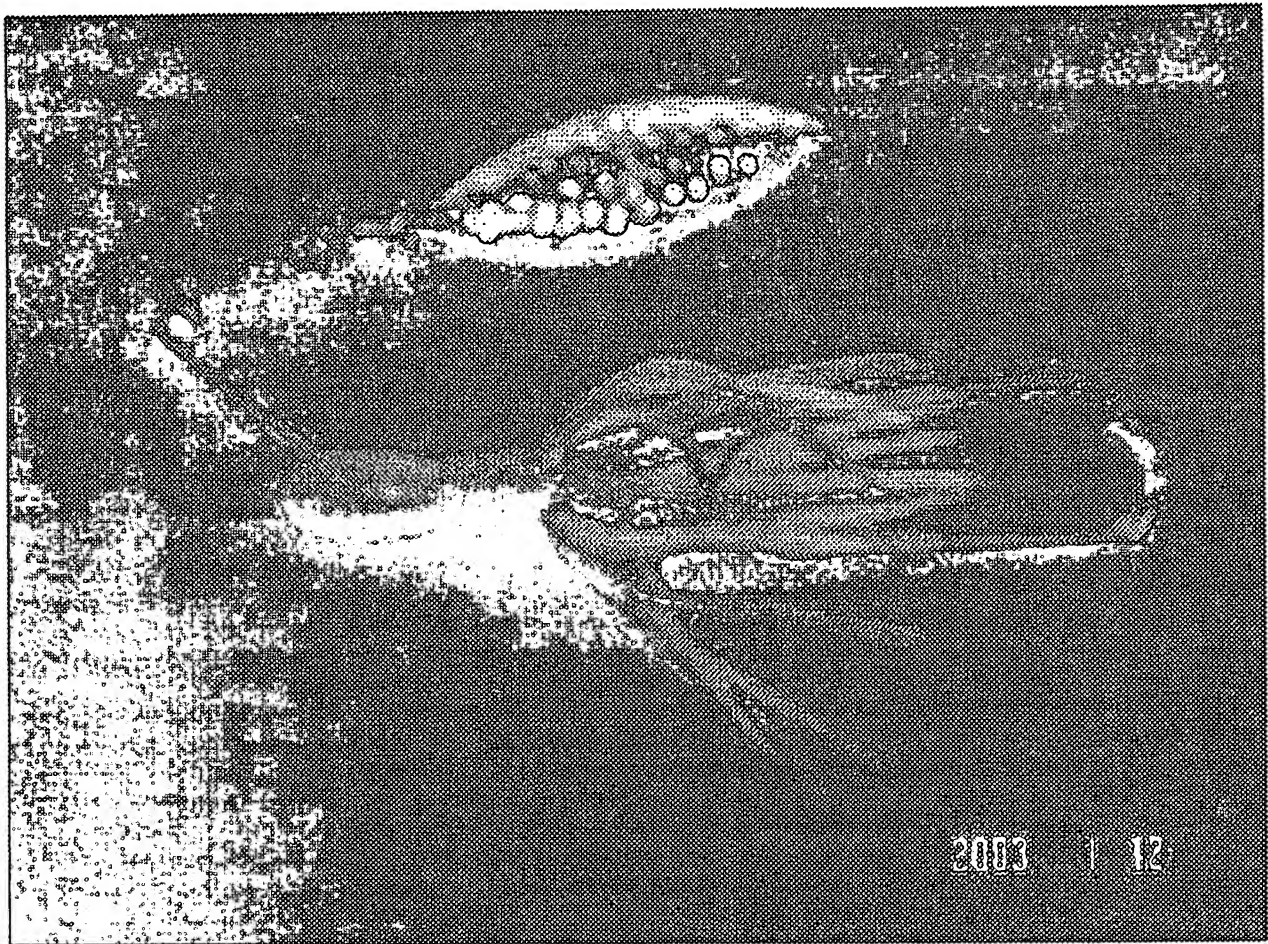
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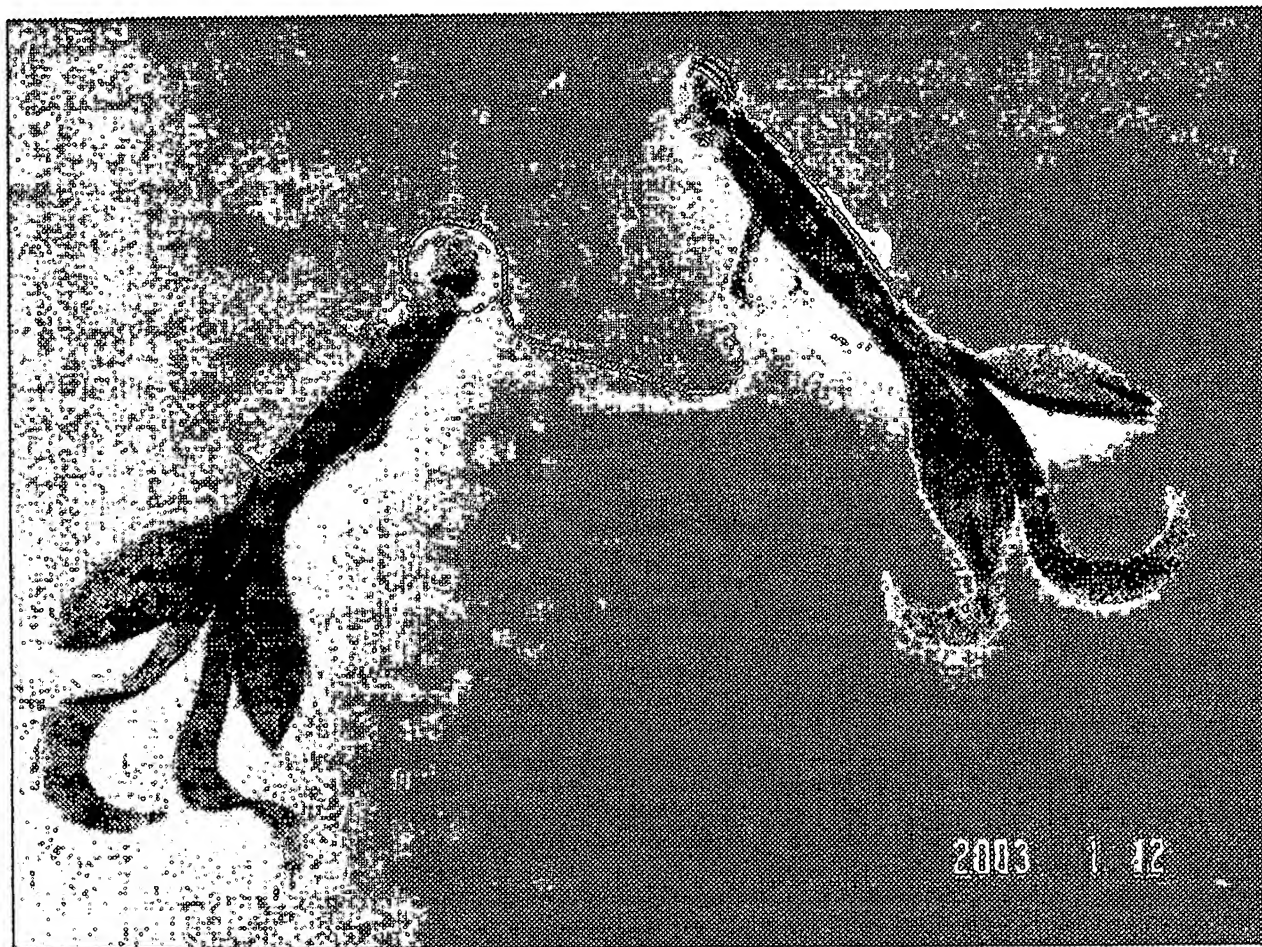
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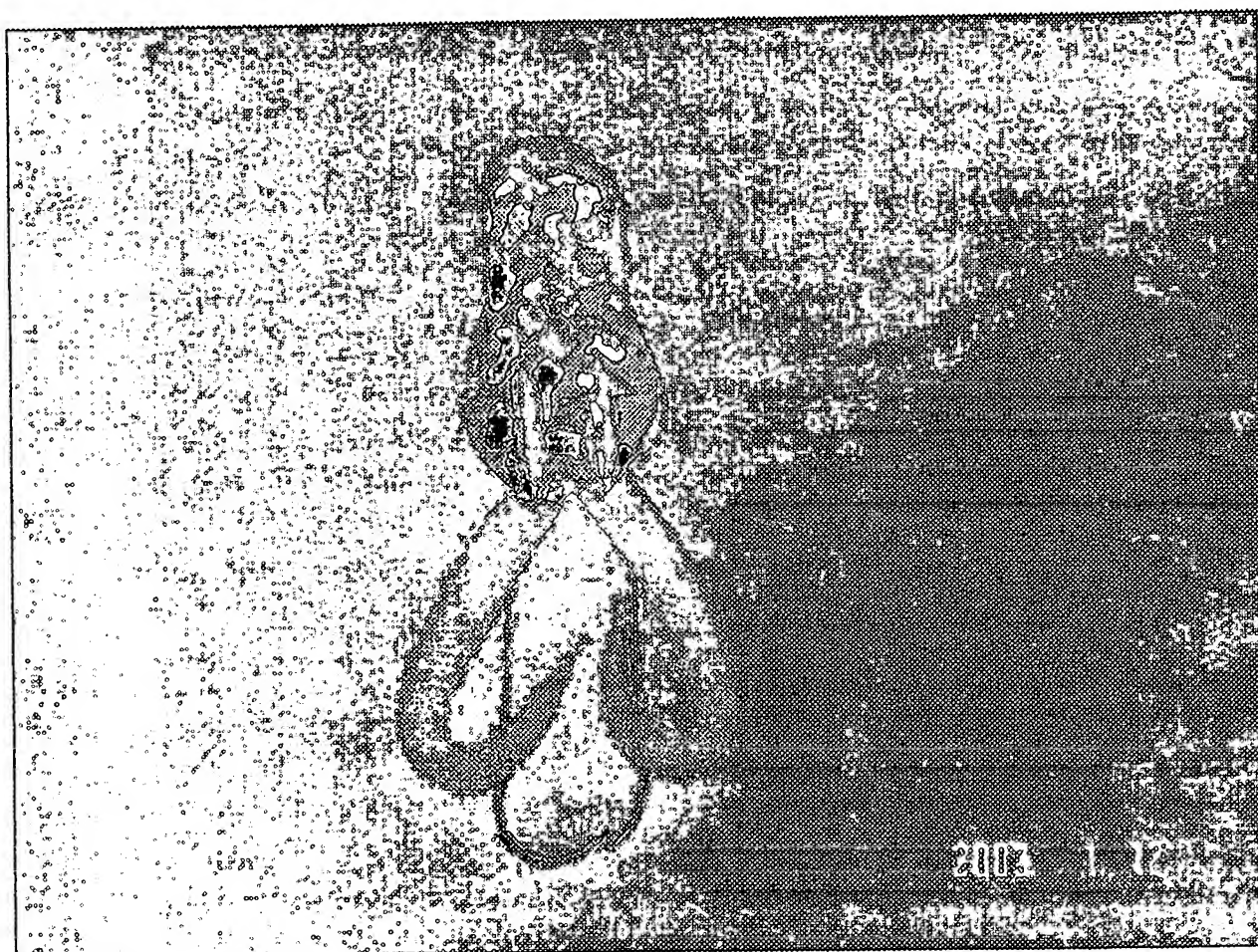
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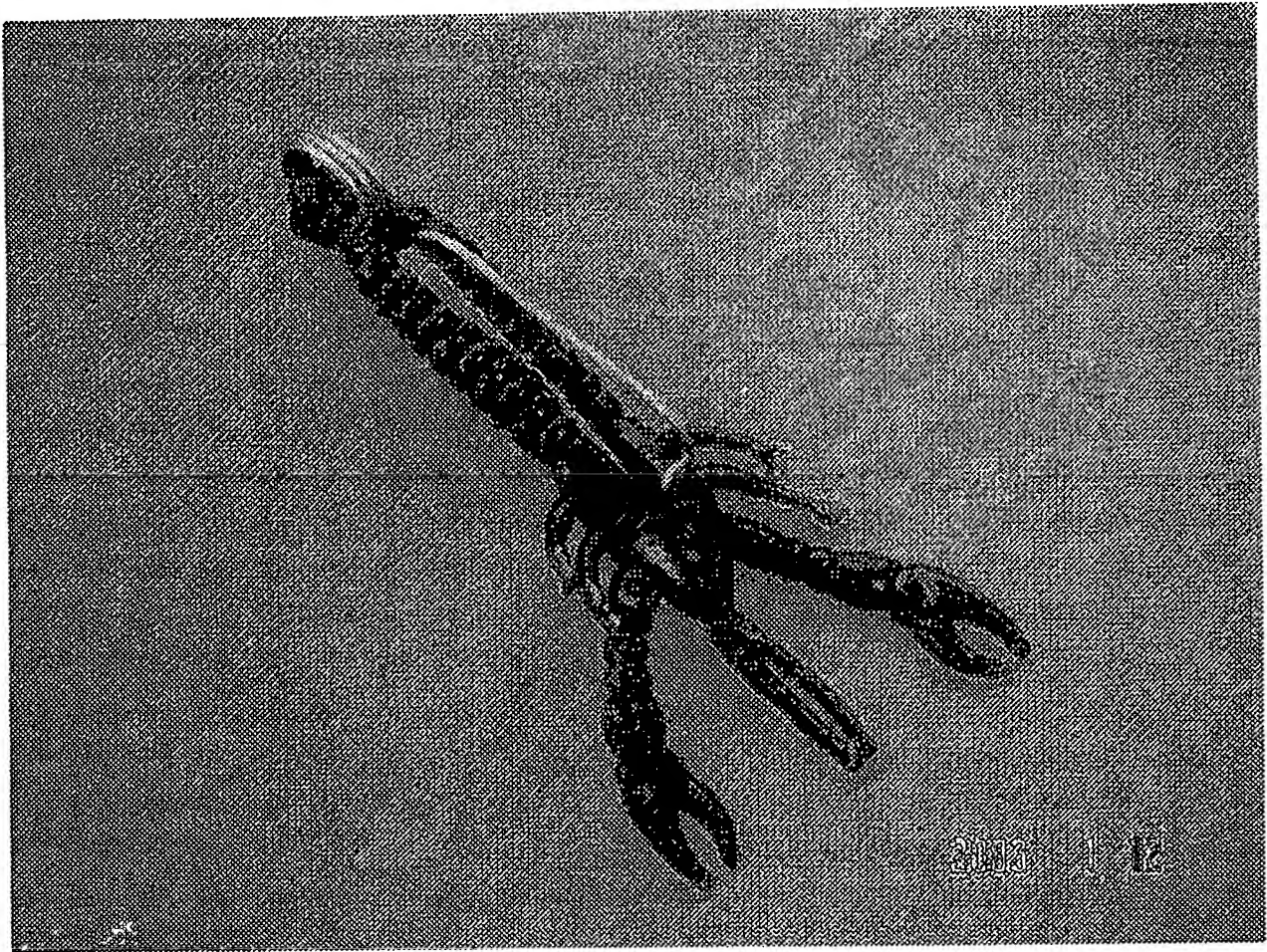
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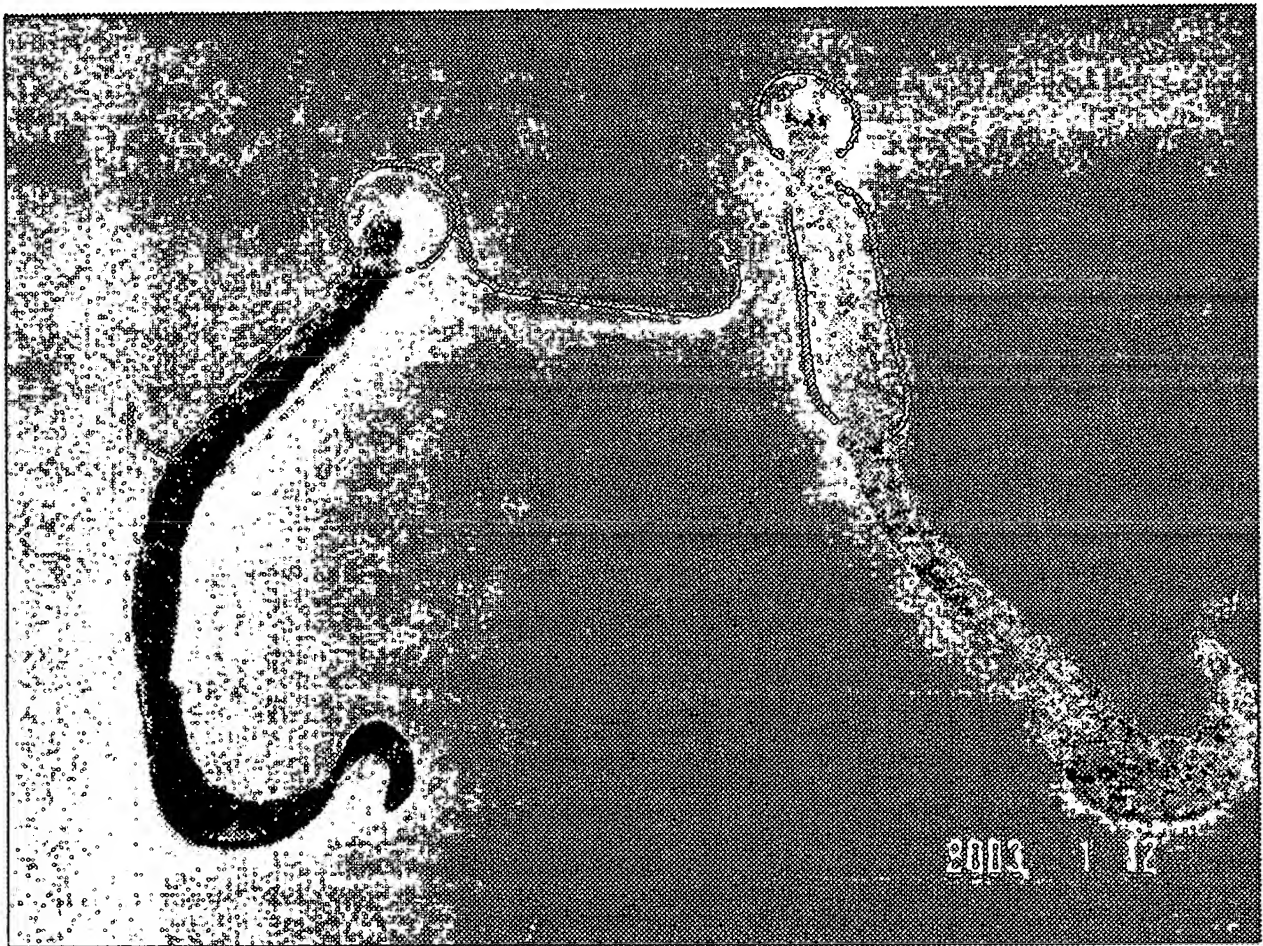
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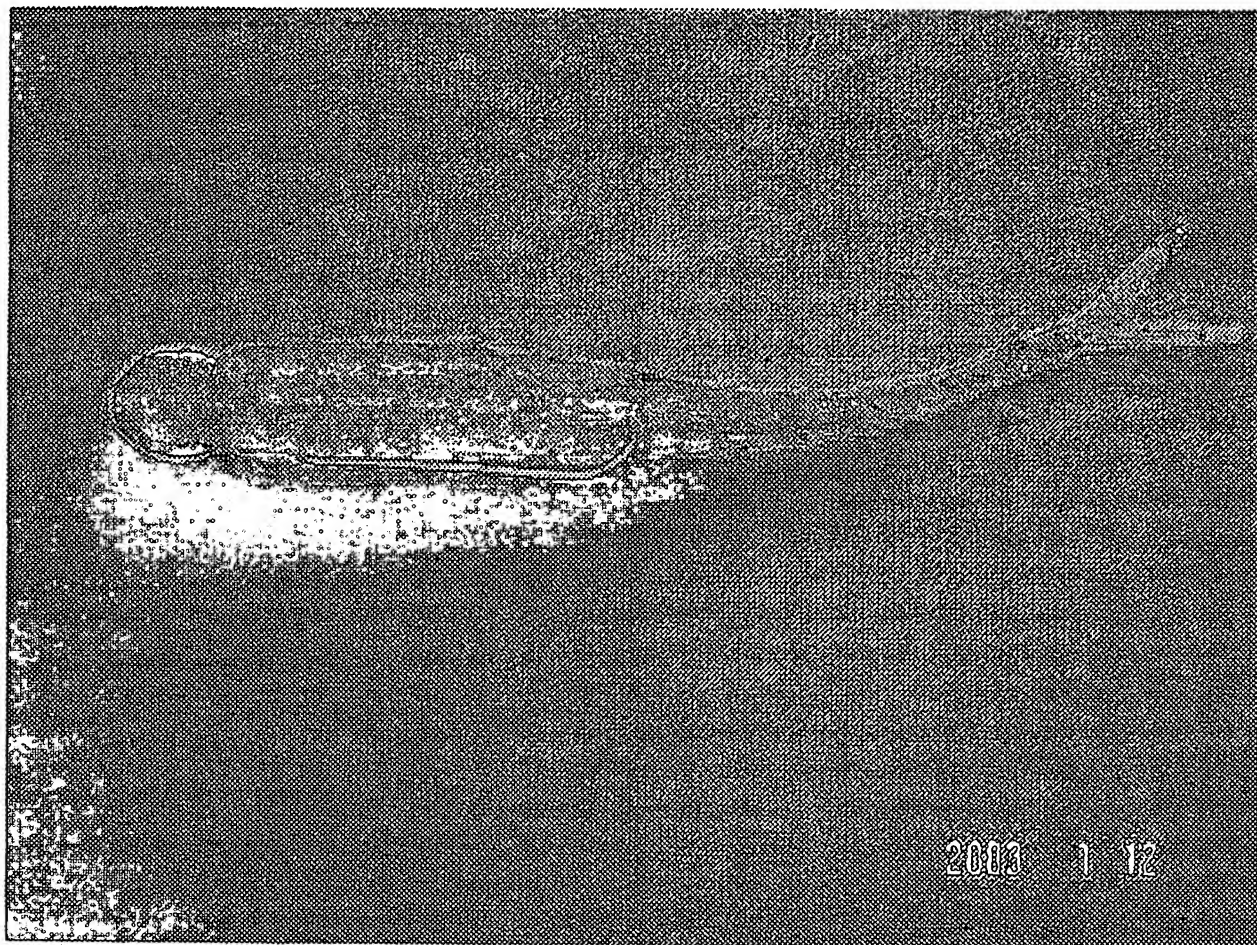
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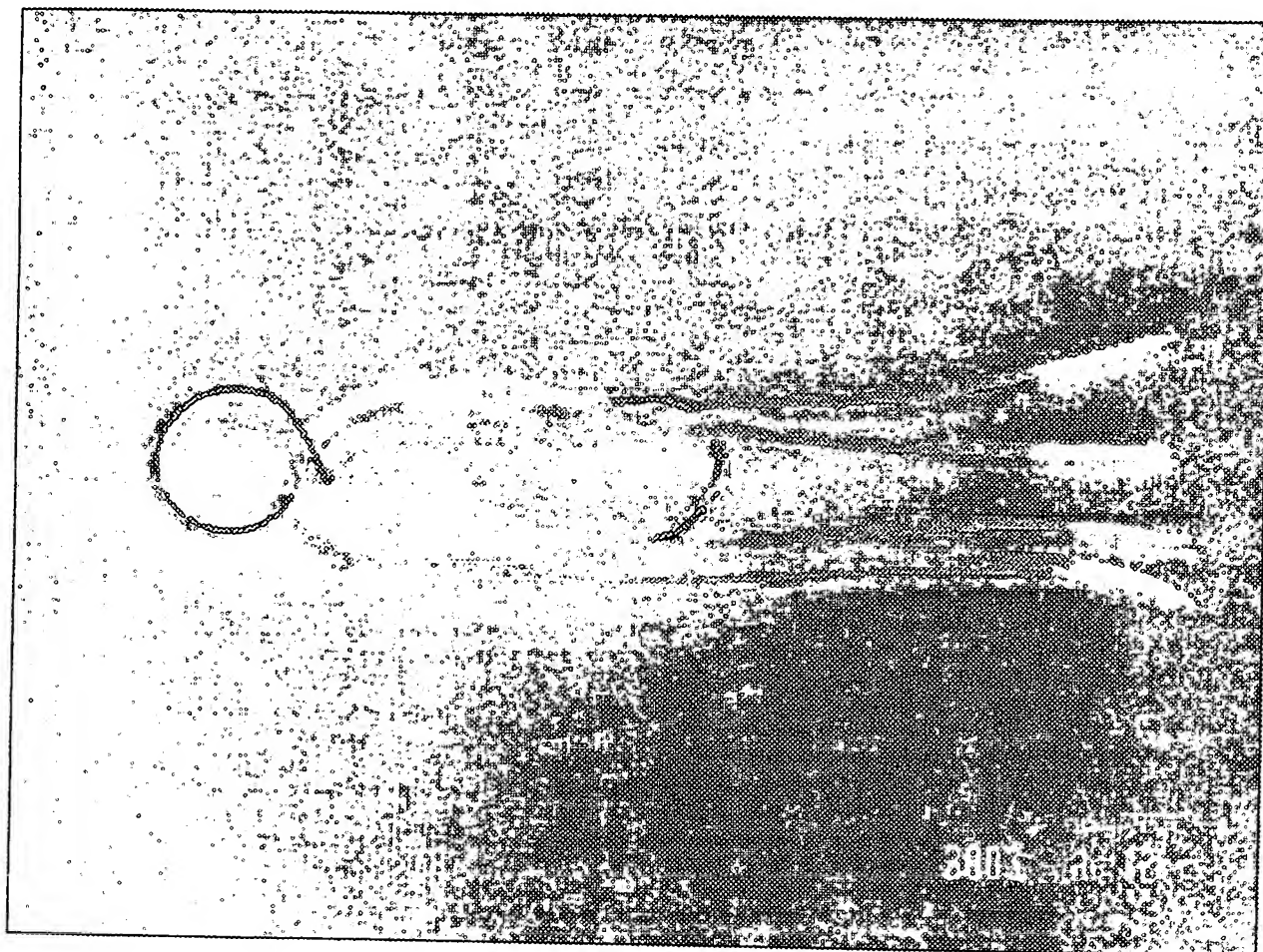
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Sheet 10/11



Sheet 11/11

10. Related Proceedings Appendix

None.